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Serial Number 10/719,048
Docket Number YOR920030227US1
Amendment1

REMARKS

Claims 1-26 have been examined. Claims 1-26 have been rejected. Claims 1-11, 13, 14, 17-20, 22, and 23 have been amended. Applicant respectfully requests reconsideration in light of the amendments and the following remarks.

CLAIM REJECTIONS UNDER 35 USC §101

The subject matter patentability analysis begins with the statute. Section 101 provides:

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”

Excluded from patent protection are laws of nature, physical phenomena, and abstract ideas. *Diamond v. Diehr*, 450 U.S. 175 (1981). The United States Court of Appeals for the Federal Circuit has noted that the repetitive use of the expansive term “any” in § 101 shows Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in § 101. *State Street Bank & Trust Co. v. Signature Fin. Group*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 851 (1999). Moreover, the Supreme Court has acknowledged that Congress intended § 101 to extend to “anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980); see also *Diamond v. Diehr*, 450 U.S. 175, 182 (1981). Thus, it is improper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations. See Chakrabarty, 447 U.S. at 308

Serial Number 10/719,048
Docket Number YOR920030227US1
Amendment1

("The Federal Circuit has also cautioned that courts 'should not read into the patent laws limitations and conditions which the legislature has not expressed.'" (citations omitted)). State Street Bank & Trust Co. v. Signature Fin. Group, supra.

The Office Action has rejected claims 18-26 under 35 USC 101 as directed to non-statutory subject matter. Claim 18, as amended, reads as follows:

A program product in a signal bearing medium, the program product comprising instructions executable by a device for presenting a hierarchical representation of a target program, the product comprising: VM instructions operable as a mixed-mode virtual machine (VM) comprising a compiler, interface instructions operable as a dynamic instrumentation interface for coupling the VM and a program instrumentation tool, further operable responsive to signaling from the interface to transform a program being operated on by the VM.

Claims 18 – 26 are directed to a program product comprising instructions for transforming a program. These claims are under the §101 category of manufacture. The Office Action has not shown that the claimed subject matter falls within one of the categories excluded from patentability. Applicant disagrees with the Office Action's assertion that claims 18 – 26 "recite nothing but the physical characteristics of a form of energy." Claim 18 and its dependent claims are directed to statutory subject matter – a computer program product comprising instructions for carrying out specific method steps for achieving a result.

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Serial Number 10/719,048
Docket Number YOR920030227US1
Amendment1

CLAIM REJECTIONS UNDER 35 USC §102

The Office Action rejected claims 1-4, 7, 9-12, and 16 under 35 USC 102(e) as being anticipated by Arnold et al. (US 6,971,091 B1). For a reference to anticipate a claim, each element and limitation of the claim must be found in the reference. Hoover Group, Inc. v. Custom Metalcraft, Inc., 66 F.3d 299, 302 (Fed. Cir. 1995).

As to claim 1, the claim, as amended, is not anticipated by Arnold. Arnold discloses a dual-compiler system wherein [7:46-51] "The recompilation subsystem takes the output of the compiler, a Java object that represents the executable code and associated runtime information (exception table information and garbage collection maps), and installs it in the JVM 101, so that all future calls to this method will use a new version." This differs from the claimed invention in that the claimed invention comprises a dynamic instrumentation interface which controls a single compiler to either a) allow a current instantiation of the first class to run until terminated; or b) replace currently running code based on an old-object method of the first class with the transformed program, based on a transformation call. Arnold teaches no such dynamic instrumentation interface allowing a compiler to make such a choice. The "instrumentation" disclosed in Arnold [6:5-10] is "instrumentation in the executing code" for producing profiling data. Claim 1, as amended, is therefore in condition for allowance.

Claim 9 is a system counterpart to claim 1 and is therefore not anticipated by Arnold for at least the same reasons that claim 1 is not anticipated by Arnold.

Claims 2 and 10 are dependent upon claims 1 and 9 and as such, are not anticipated

Serial Number 10/719,048
Docket Number YOR920030227US1
Amendment1

for at least the same reasons that their base claims are not anticipated.

Claims 3 and 11 are dependent upon claims 1 and 9 and as such, are not anticipated for at least the same reasons that their base claims are not anticipated.

Claims 4 and 12 are dependent upon claims 1 and 9 and as such, are not anticipated for at least the same reasons that their base claims are not anticipated.

Claims 7 and 16 are dependent upon claims 1 and 9 and as such, are not anticipated for at least the same reasons that their base claims are not anticipated.

CLAIM REJECTIONS UNDER 35 USC §103

The Office Action rejected claims 5 and 13 under 35 USC 103(a) as being unpatentable over Arnold et al. as applied in claims 2 and 10, in view of Sexton et al. (USPN 6,854,114 B1). Applicant respectfully disagrees. Arnold was, at the time the claimed invention was made, assigned to the same assignee as the claimed invention, International Business Machines Corporation. 35 USC 103(c) asserts: "(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." Therefore, the 103 rejection is rendered moot and claims 5 and 13 are allowable.

The Office Action rejected claims 6, 8, 15 and 17 under 35 USC 103(a) as being unpatentable over Arnold et al. as applied in claims 2, 7, 10, and 16 in view of Sexton et al. The

Serial Number 10/719,048
Docket Number YOR920030227US1
Amendment1

103 rejection to claims 6, 8, 15 and 17 is rendered moot for the reason discussed above;
therefore claims 6, 8, 15 and 17 are allowable.

Serial Number 10/719,048
Docket Number YOR920030227US1
Amendment1

For the foregoing reasons, Applicant respectfully requests allowance of the pending claims.

Respectfully submitted,

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Certificate of Facsimile Transmission

I hereby certify that this Amendment and Response to Office Action, and any documents referred to as attached therein are being facsimile transmitted on this date, **January 8, 2007**, to fax number 571 273-8300.

Michael J. Buchenhorner

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Date: January 8, 2007